

Notice of Allowability

Application No.

10/053,753

Examiner

Joseph T. Voitach

Applicant(s)

LAU

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to ____.
2. ☒ The allowed claim(s) is/are 65 and 67-77.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: ____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
(a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
1) ☐ hereto or 2) ☐ to Paper No./Mail Date ____.
(b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date ____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date ____. |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date ____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other ____. |

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Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 11, 2005 has been entered.

DETAILED ACTION

This application filed January 22, 2002, is a continuation of 09/142,569, filed April 2, 1999, now US Patent 6,413,735, which is a national stage entry of PCT/US97/04193, filed March 14, 1997, which claims priority to provisional application 60/013,958.

Applicant's amendment filed October 11, 2005, has been received and entered. Claims 1-64, 66 and 78-81 have been canceled. Claims 65 and 67 has been amended. Claims 65, 67-77 are pending

Election/Restrictions

Applicant's election without traverse of the species of SEQ ID NO: 4 and fragments thereof in the reply filed on July 19, 2004 was acknowledged. The restriction requirement for election of species was withdrawn.

It is noted that now cancelled claims 78-81 were withdrawn from consideration as being directed to a non-elected invention (see 37 CFR 1.142(b) and MPEP § 821.03) because they

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were drawn to several different methods of using a Cyr61 antibody, not the product itself. At this point withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim would be rejoined in accordance with the provisions of MPEP 821.04, and the restriction requirement withdrawn. However no process claims are presently pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 65-, 67-69, 75-77 rejected under 35 U.S.C. 102(b) as being anticipated by O'Brien *et al.* (IDS ref C24) is withdrawn.

Claims 65, 67-69, 75-77 rejected under 35 U.S.C. 102(b) as being anticipated by Yang *et al.* (IDS ref C29) is withdrawn.

The amendment to the claims that distinguish the ability of the antibody to bind to a sequence previously not known in the prior art has differentiated the claimed invention from that previously disclosed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 65, 67-77 rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brien *et al.* or Yang *et al.* and Hoogenboom *et al.* (US Patent 5565332 A) is withdrawn.

As discussed above, the amendment to the claims distinguishes the ability of the claimed antibody to bind to a sequence previously not known in the prior art differentiates the claimed invention from that previously disclosed. Yang *et al.* and Hoogenboom *et al.* cited for embodiments commonly present in antibodies fails to make obvious the specific sequence of SEQ ID NO: 4, or the ability of an antibody to bind this sequence that is divergent from previously known sequences.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 67 objected to under 37 CFR 1.75 as being a substantial duplicate of claim 65 is withdrawn.

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The claim amendments provides for slightly different scopes of polypeptide to which the claimed antibody binds, where claim 67 is a fusion protein and thus may include antigen determinants in addition to those that are divergent between SEQ ID NO: 4 and 2.

Examiner's Amendment

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Teddy C. Scott, Jr. on January 20, 2006.

The application has been amended as follows:

Change the title to read:

"Antibody for human Cyr61".

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Reasons for Allowance

The following is an examiner's statement of reasons for allowance:

The claims have been amended to reflect and encompass sequence information that was not known in the prior art. Consequently, there is no anticipation nor obvious motivation to provide for the specific antibody now claimed. While Cyr61 in other species of mammals was known at the time of filing, and was known to share homology among known species, human Cyr61 was not known (i.e. SEQ ID NO: 4). Antibodies that bind to Cyr61 were previously disclosed, however the disclosure of SEQ ID NO: 4 provides for the ability to identify divergent sequences between known sequences such as SEQ ID NO: 2, and provide antigenic peptides to obtain the instantly claimed antibody.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Woitach whose telephone number is (571) 272-0739.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached at (571) 272-0735.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group analyst Dianiece Jacobs whose telephone number is (571) 272-0532.

Joseph T. Woitach

JOSEPH WOITACH, PH.D.
PRIMARY EXAMINER

Joe Woitach
A01632